REMARKS

Claim Rejections - 35 USC § 112

Claim 13 is rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the description requirement. Claim 13 as amended in the Submission under 37 C.F.R. § 1.114 filed April 6, 2009, recites that in the method of producing a three-layer fiber product recited in claim 1, the middle layer and the surface layers each comprise a mixture of chemical cellulose pulp and mechanical pulp, and that a mechanical pulp, which is coarser than that used for forming one surface layer, optionally is used for forming the other surface layer.

The position of the Office is that there is no teaching in the specification of an embodiment of the three-layer product where one of the surface layers containing the claimed filler is made from a different mechanical pulp than the other surface layer containing the claimed filler and a person of ordinary skill in the art would not deduce such an embodiment from a reading of the present specification.

Applicants respectfully submit that a person of ordinary skill in the art would recognize from the specification disclosure that the embodiment that is claimed in claim 13 is included within the overall scope of applicant's invention since it is not excluded

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from the scope of the invention and since there is no reason why two surface layers could not be made from mixtures of chemical cellulose pulp and mechanical pulp in which the mechanical pulp in one mixture is different from that in the other mixture.

However, in order to expedite an allowance of claims in the present application, claim 13 has been amended to recite that a mechanical pulp, which is coarser than that used for forming the surface layers, optionally is used for forming the middle layer.

Claim 13 as amended is believed to be supported by the descriptions in the specification disclosure noted in the Action and removal of the 35 U.S.C. § 112, first paragraph, rejection is in order.

Claim Rejections - 35 USC § 103

The Office has removed the 35 U.S.C. § 103(a) rejection of the claims as being unpatentable over Silenius et al. (US 2004/0168779) in view of Begemann et al. (EP 0824157) and further in view of Peel et al. (Paper Science and Paper Manufacture) that was made in the previous Action. The Office is now rejecting the claims under 35 U.S.C. § 103(a) over Silenius in view of Ruf et al., EP 0824157 ("Ruf"), and further in view of Peel.

The citation of Ruf does not appear to change the issue raised by the 35 U.S.C. § 103(a) rejection. The issue is whether a person

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of ordinary skill in the art would have been motivated or had another reason for using "SuperFill" as a filler of the surface layers of a three-layer fiber product produced by a multilayer forming process as disclosed in the prior art with an expectation of good results.

Without specifically addressing the issue of whether or not the Office has supported a case of *prima facie* obviousness of the claims of the present application, applicants again respectfully submit that the comparative data in the application demonstrate non-obviousness sufficient to overcome any *prima facie* obviousness that may be considered to be supported by the Office's combinations of references.

In particular, Example 2 of the present specification shows, as identified in Table 4 and the corresponding Figures 4 and 5, that surprisingly great improvements can be obtained with the present invention. Test point 11 is a multilayered paper formed by the present invention using the "SuperFill" filler within the scope of the present claims. The multilayered paper has an air permeability of 274 ml/min. By contrast, Test Point 10b, which was produced on the same apparatus as Test Point 11 using a commercial PCC filler, had a 74 % higher air permeability ((476-274)/274 * 100). This is a material difference, and is of particular

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importance with regards to thin papers. There is nothing in the prior art that would have led a person of ordinary skill in the art to expect such an increase.

In the present Action, the Office has taken the positions that it is not known if the composition of the "SuperFill" filler used in the examples is within the scope of the present claims and that the data are not commensurate in scope with the claims.

The Office does not have a proper basis for questioning whether the "SuperFill" filler used in Example 2 is within the scope of the claims. The present specification describes on page 3, lines 17-21, that the filler used in the surface layer of the multilayer product produced in the process of the present invention is described in FI Patent Specification No. 100729. The present specification further describes on page 5, lines 7-9, that the product name "SuperFill" is used in the present specification for the filler used in the present invention, i.e., the filler disclosed in FI Patent Specification No. 100729. Moreover, Example 2 describes that the PCC content in the SuperFill filler used in the example was 67.5 %, which is within the maximum content of 85 % recited in the present claims and described on page 3, lines 17-21, of the present specification.

When these descriptions of the SuperFill filler being within

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the scope of the present invention are considered in light of the paramount obligation of candor and good faith of an applicant to the USPTO, the Office has no basis to question whether the composition of the SuperFill filler used in the example is within the scope of the claims.

Regarding the scope of the claims, applicants have amended claim 1 to include the limitations of claims 8 and 15 and to recite that the amount of the filler in the surface layers is 5-50 % by weight of the fibers of the surface layer. This latter limitation is supported by the description in the present specification on page 6, lines 28-29. In light of this amendment to claim 1 and the assertion in the specification that other fillers within the scope of the present invention provide comparable results (see, for example, page 17, lines 4-5), and again considering applicants' obligation of candor and good faith, it is respectfully submitted that there is not an adequate basis for a person of ordinary skill in the art to reasonably conclude that the number and variety of compositions included by the claims would not behave in the same manner as the tested multilayer paper. *See In re Saunders*, [58 CCPA 1316] 58 CCPA 1316, 1324, [444 F2D 599] 444 F.2d 599, 605, 170 USPQ 213, 218 (1971).

Removal of the 35 U.S.C. § 103(a) rejection is requested.

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PATENT APPLN. NO. 10/532,481 **PATENT**
RESPONSE UNDER 37 C.F.R. §1.111 **NON-FINAL**

Double Patenting

Claims 1 and 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting ("ODP") as being unpatentable over claim 12 of copending Application No. 10/475773 in view of Ruf.

Applicants request that this rejection be held in abeyance pending a determination of allowable subject matter in this or the related application.

The foregoing is believed to be a complete and proper response to the Office Action dated May 18, 2009.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension and any additional required fees may be charged to Deposit Account No. 111833.

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